

## REMARKS

### Summary of Office Action

Claims 1-51 and 55-76 are pending in this application.

The Examiner allowed claims 51 and 55-76.

Claims 14, 19, 20, 38, 43, and 44 were objected to for being dependent upon a rejected base claim, but were indicated to be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims.

The Examiner rejected claims 1-12, 15-17, 21-23, 27-36, 39-41, and 45-47 under 35 U.S.C. § 102(e) as being anticipated by Markworth et al. U.S. Patent No. 6,660,006 (hereinafter "Markworth").

The Examiner rejected claims 1, 11, 16-18, 27, 35-37, and 40-42 under 35 U.S.C. § 102(b) as being anticipated by Beale et al. U.S. Patent No. 6,440,133 (hereinafter "Beale").

Dependent claims 12 and 13 were rejected under 35 U.S.C. § 103(a) as being obvious from Beale, and dependent claims 24-26 and 48-50 were rejected under 35 U.S.C. § 103(a) as being obvious from Markworth in view of Errico et al. U.S. Patent No. 5,688,274 (hereinafter "Errico").

The Examiner rejected claims 9 and 32 under 35 U.S.C. § 112, second paragraph, for an antecedence problem.

### Summary of Applicants' Reply

Applicants appreciate the allowance of claims 51 and 55-76 and the indication that claims 14, 19, 20, 38, 43, and 44 contain allowable subject matter.

Claims 9 and 32 have been amended to correct the antecedence problem.

Claims 27 and 40 were amended for minor informalities unrelated to patentability.

No new matter has been added.

Reconsideration of this application in view of the amendments and following remarks is respectfully requested.

Rejections of Claims 1-12, 15-17, 21-23, 27-36, 39-41, and 45-47 Under 35 U.S.C. §102(e)

Claims 1-12, 15-17, 21-23, 27-36, 39-41, and 45-47 were rejected under 35 U.S.C. § 102(e) as being anticipated by Markworth.

These rejections are respectfully traversed.

Independent Claims 1 and 16

Independent claims 1 and 16 define a surgical instrument having a release assembly that includes a tubular member. The tubular member is sized and configured to be slidably disposed within a holder assembly. The surgical instruments defined in claims 1 and 16 also have an actuating member that moves the holder assembly with respect to the release assembly.

The Examiner said that Markworth discloses “a tubular member (300) ... slidably disposed (partially) within [a] holder assembly (200)” (August 18, 2006 Office Action, page 3).

Applicants disagree.

Markworth discloses a U-shaped slide 300 having an open channel 310.

Slide 300 is plainly not a tubular member.

“[S]lide 300 fits on top of the body 200 ...” (Markworth column 6, line 41; emphasis added). “There is room for the slide to advance longitudinally forward on top of the body ...” (*id.* at lines 43-44; emphasis added). Slide 300 is plainly not disposed within, not even partially, a holder assembly.

The Examiner also said that Markworth discloses an actuating system having a first grip 514 and a second grip 218 (August 18, 2006 Office Action, page 4). Markworth discloses that pistol grip 218 is attached to or integral with body 200 (*see* Markworth column 5, lines 59-64), while handle 514 is attached to or integral with trigger 500 (*see id.* at column 6, lines 23-27). “Screws ... secure the trigger to the slide 300 ...” (*id.* at lines 39-40).

As shown in Markworth’s FIGS. 1A and 1B, the actuating system of Markworth moves slide 300 and sleeve 400 (which the Examiner equated to applicants’ release assembly) with respect to body 200 (which the Examiner equated to applicants’ holder assembly).

Markworth therefore does not disclose or suggest an actuating member that moves the holder assembly with respect to the release assembly as required in claims 1 and 16.

Thus, because Markworth does not meet several limitations of independent claims 1 and 16, these claims are not anticipated by Markworth.

#### Independent Claims 27 and 40

Independent claims 27 and 40 also require the actuating member to move the holder assembly with respect to the release assembly.

Thus, because Markworth moves slide 300 and sleeve 400 (its “release

assembly”) with respect to body 200 (its “holder assembly”), Markworth does not anticipate claims 27 and 40.

\* \* \*

In sum, Markworth’s rod persuader does not meet the limitations of independent claim 1, 16, 27, or 40. Therefore, these claims are not anticipated by Markworth and should be allowable.

For at least these reasons, dependent claims 2-12, 15, 17, 21-23, 28-36, 39, 41, and 45-47, which depend directly or indirectly from one of independent claims 1, 16, 27, and 40, should also be allowable (i.e., dependent claims are allowable if their independent claim is allowable).

Accordingly, applicants respectfully request that the rejections of claims 1-12, 15-17, 21-23, 27-36, 39-41, and 45-47 under 35 U.S.C. §102(e) be withdrawn.

Rejections of Claims 1, 11, 16-18, 27, 35-37, and 40-42 Under 35 U.S.C. §102(b)

Claims 1, 11, 16-18, 27, 35-37, and 40-42 were rejected under 35 U.S.C. §102(b) as being anticipated by Beale.

These rejections are respectfully traversed.

The Examiner’s First Interpretation

The Examiner said in a first interpretation that Beale’s reducing member 100 equates to applicants’ holder assembly and that Beale’s fastener engaging member 80 and extension member 500 equate to applicants’ tubular member and pusher member, respectively, of applicants’ release assembly.

Independent claims 1 and 16 require the release assembly to comprise a tubular member and a pusher member. As disclosed in applicants' specification, the pusher member is attached to the tubular member.

Beale's extension member 500, however, is not attached to nor a part of fastener engaging member 80, but is instead an optional extension of reducing member 100 (which the Examiner equated to applicants' holder assembly). Beale discloses that "extension member 500 can be positioned about reducing member 100 ... and held with respect thereto via frictional engagement, threaded engagement, a set screw or the like" (Beale column 7, lines 17-20). Because "reducing member 100 is movable ... with respect to fastener engaging member 80" (*id.* at column 4, lines 65-67), extension member 500 cannot also be attached to or a part of fastener engaging member 80 without rendering fastener engaging member 80 and reducing member 100 immovable with respect to each other.

Thus, the Examiner's first interpretation of Beale does not anticipate independent claims 1 and 16.

Independent claims 27 and 40 require the holder assembly to have a pair of fingers operative to hold a spinal implant.

Beale's reducing member 100 (which the Examiner equated to applicants' holder assembly) has no fingers or structure whatsoever for holding a spinal implant or anything else. Unlike applicants' invention, Beale's fastener engaging member 80 (which the Examiner equated to applicants' release assembly) has prongs 94 and 96 operative to hold a fastener F.

Thus, the Examiner's first interpretation of Beale also does not anticipate independent claims 27 and 40.

The Examiner's Second Interpretation

The Examiner said in a second interpretation that Beale's fastener engaging member 80 equates to applicants' holder assembly and that Beale's reducing member 100 equates to applicants' release assembly.

Independent claims 1, 16, 27, and 40 each require that an actuating member move the holder assembly with respect to the release assembly.

Beale, however, discloses that its actuator assembly is coupled "such that reducing member 100 is movable ... with respect to fastener engaging member 80" (Beale column 4, lines 65-67).

Thus, the Examiner's second interpretation of Beale does not anticipate independent claims 1, 16, 27, and 40.

\* \* \*

In sum, Beale's rod reducer instruments do not meet the limitations of independent claim 1, 16, 27, or 40. Therefore, these claims are not anticipated by Beale and should be allowable.

For at least these reasons, dependent claims 11, 17, 18, 35-37, 41, and 42, which depend directly or indirectly from one of independent claims 1, 16, 27 and 40, should also be allowable (i.e., dependent claims are allowable if their independent claim is allowable).

Accordingly, applicants respectfully request that the rejections of claims 1, 11, 16-18, 27, 35-37, and 40-42 under 35 U.S.C. §102(b) be withdrawn.

Rejections of Dependent Claims 12, 13, 24-26, and 48-50 Under 35 U.S.C. § 103(a)

Dependent claims 12 and 13 were rejected under 35 U.S.C. § 103(a) as being obvious from Beale, and dependent claims 24-26 and 48-50 were rejected under 35 U.S.C. § 103(a) as being obvious from Markworth in view of Errico.

These rejections are respectfully traversed.

For at least the reasons discussed above with respect to independent claims 1 and 27, dependent claims 12, 13, 24-26, and 48-50, which each depend directly or indirectly from one of those independent claims, are not obvious from Beale or Markworth in view of Errico (i.e., dependent claims are allowable if their independent claim is allowable).

Accordingly, applicants respectfully request that the rejections of claims 12, 13, 24-26, and 48-50 under 35 U.S.C. §103(a) be withdrawn.

Objections to Claims 14, 19, 20, 38, 43, and 44

Dependent claims 14, 19, 20, 38, 43, and 44 were objected to as being dependent upon a rejected base claim, but were indicated to be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims.

These objections are respectfully traversed.

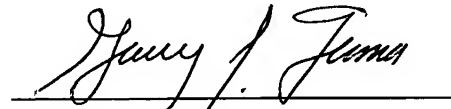
For at least the reasons discussed above with respect to independent claims 1, 16, 27, and 40, dependent claims 14, 19, 20, 38, 43, and 44, which indirectly depend from one of claims 1, 16, 27, and 40, should no longer be objectionable.

Accordingly, applicants respectfully request that the objections to claims 14, 19, 20, 38, 43, and 44 be withdrawn.

Conclusion

The foregoing demonstrates that claims 1-51 and 55-76 are allowable. This application is therefore in condition for allowance. Reconsideration and allowance are accordingly respectfully requested.

Respectfully submitted,

A handwritten signature in cursive script, reading "Garry J. Tuma", is written over a horizontal line.

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